

Int 317 50. (Amended) A method for printing original documents at a user location, the method comprising:

- A12*
- (a) printing an original document at least partially contained within an image file with a printer responsive to a printer resident driver; and
 - (b) authorizing (a) with a driver resident on a processor geographically remote from the printer.

Int 317 54. (Amended) A method for printing original documents at a user location, the method comprising:

- A13*
- (a) transmitting first data for a first original document to a printer via a computer network;
 - (b) printing the first original document responsive to the first data with a printer;
 - (c) transmitting second data for a second original document to the printer via the computer network, the second original document being a different type of document than the first original document, at least one of the first and second original document at least partially contained within an image file; and
 - (d) printing the second original document responsive to the second data with the printer.

Remarks

Summary

Claims 1-67 were pending. Claims 1, 5-7, 13, 16, 20, 22, 23, 30, 42, 46, 50, and 54 have been rewritten. No new matter has been added as a result of this amendment.

35 U.S.C. §112, first paragraph rejection of claims

In the Office Action of September 25, 2002, Claim 35 was rejected under 35 U.S.C. §112, first paragraph as containing subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More specifically, the Examiner stated that the specification discloses only that printing data is printed on

a label instead of directly on a CD ROM, as recited in Claim 35. However, page 9, line 21 to page 10, line 5 of the specification clearly discloses that printing data such as music or games may be downloaded and printed directly on a CD ROM and that the printing data such as a label may also be printed. Thus, Applicant submits that the specification discloses more than merely that printing data is printed on a label, disclosing that the printing data may be printed for example, on a CD ROM or as a label.

35 U.S.C. §112, second paragraph rejection of claims

In the Office Action, Claims 5-7, 9, 16, 22, and 27 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Applicant has amended Claims 5, 7, and 16 to correct any antecedent basis problems. The Examiner also rejected Claims 6, 22, and 27 as being unclear for not explaining how the online electronic communication method replenishes the consumer's printer with supplies. Applicant submits that, as disclosed on for example page lines 13-22 of the specification, it is clear that in one embodiment of the method, a consumer's printer prints data supplied from a remote source and this remote source (or an intermediary printer maintenance company) may monitor the printer supplies and replenish the printer with supplies when the supplies reach a particular point by for example, sending printing supplies to the consumer. This is to say that in such an embodiment, as recited the method is not merely limited to communicating to the printer from a remote location, but actually maintains the printer supplies to the benefit of both the consumer and the remote seller. Applicant thus submits that Claims 5-7, 9, 16, 22, and 27 overcome the rejections.

35 U.S.C. §102(e) rejection of claims

In the Office Action, Claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-31, 33-35, 41, 46-56, 60, and 62-63 were rejected under 35 U.S.C. §102(e) as being anticipated by Ryan Jr. (U.S. Patent 6,064,993). Applicant has rewritten Claims 1, 5-7, 16, 20, 22, 23,

30, 42, 46, 50, and 54 and submits that all of the pending claims are in condition for allowance.

Claim 1, for example, recites a method for conducting electronic transactions that comprises establishing communication connections between a provider and both a consumer and the consumer's printer in which a request for a transaction is submitted to the provider, the transaction processed and electronic certificate data generated, the electronic certificate data (which is at least partially contained within an image file) is transmitted to the printer, and the printing of the electronic certificate on the printer is controlled by the provider. Other methods or systems recited in the claims include transferring or printing authorized document data, authentic certificates, or original documents. Such methods and systems permit the electronic certificate (or other similar objects) and any associated image to be printed by a third party without the consumer having to control the printing. This decreases multiple problems that the consumer may encounter such as those between the printer and the consumer's computer.

Ryan Jr. does not anticipate or disclose such methods or systems. Ryan Jr. only teaches a method of transferring indicia data needed for printing of metered stamps on a remote printer. Ryan teaches that this indicia data includes piece count, postage amount, origin zip, printer identification, date, digital tokens (which are used to authenticate the information imprinted on a piece of mail including postal value) and check digits. However, this indicia data does not include image data, i.e. Ryan Jr. does not teach or suggest transferring at least an image file, that is, an image file as well as perhaps other non-image printing data. Moreover, Ryan is specifically directed to such methods as printing stamps for metered mail. That is, Ryan nowhere anticipates or suggests a method or system in which image data is used to print specialized images (such as a ticket or certificate) and that may incorporate other, non-image data (such as seat number, identification code, or certificate number). As recited in a number of the claims, material that is transferred and/or printed from the provider (or intermediary) may contain such image data or image data as well as other non-image data.

For at least this reason, Ryan does not anticipate or disclose the methods and systems recited in Claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-31, 33-35, 41, 46-56, 60, and 62-63. Thus, the pending claims are patentable over the prior art.

35 U.S.C. §103(a) rejection of claims

In the Office Action, Claims 6, 10-13, 15-19, 22, 27, 38-40, 42-45, 57-59, 61, and 64-67 were rejected under 35 U.S.C. §103(a) as being unpatentable over Ryan Jr. and Claims 32 and 36-37 were rejected as being unpatentable over Ryan Jr. in view of Golden (U.S. Patent 5,761,648). Applicant submits that the rejections on which the base claims of Claims 6, 10-13, 15-19, 22, 27, 32, 36-40, 42-45, 57-59, 61, and 64-67 have been overcome and thus all of the pending claims are in condition for allowance.

In addition, Applicant submits that Claims 11-13, 15, 18-19, 38-40 57-59, 61, and 64-65 are independently patentable over the prior art cited by the Examiner. In the Office Action, the Examiner stated that Ryan does not disclose printing original financial certificates, tickets, stamps, or credit/debit/pre paid cards that are activated for immediate use. The Examiner further states that Ryan suggests printing such documents since 1) the instant specification admits that as long as a suitable printer is available these items may be printed if the information is downloaded from a remote source, 2) Ryan teaches transmitting data to printer from a remote source to print the desired indicia on any medium, and 3) Official Notice is taken of the "concepts and benefits" of printing these original documents. However, Applicant submits that 1) Ryan only discloses transferring data for, for example, metered mail as well as using a printer for printing metered mail but does not suggest the use of any other printer, especially a printer that may need to print specialized documents, 2) the instant specification does not suggest and may not be used to suggest exchanging the printer of Ryan with a printer that is perhaps more complicated and needed to print the original documents, 3) the no prior art has been presented that suggests or motivates the use of printer necessary to print such documents, and 4) there is no motivation in the prior art to combine the use of such a printer with the method of Ryan. In addition, Applicant notes the taking of "Official Notice" by the Examiner in relation to the concepts and benefits of printing these original documents. Applicant understands this taking as an effort to

supply claim elements from the Examiner's personal knowledge. As noted in the MPEP 2144.03, with reference to 37 CFR 1.104(d)(2):

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and **the facts must be supported**, when called for by the applicant, by an affidavit from the examiner. [Emphasis added]

Accordingly, Applicant hereby requests, under 37 CFR 1.104(d)(2), that the Examiner provide an affidavit in support of the Official Notice taken based on the Examiner's personal knowledge.

Also, Claims 6, 22, 27, 42-45, and 66-67 are independently patentable over the prior art cited by the Examiner. Amended Claim 6, for example, recites that the provider confirms that the printer has sufficient supplies and replenishes the printer with supplies. The Examiner has taken Official Notice that it is notoriously well known of the concepts and benefits of confirming that the printer has sufficient supplies and replenishing the printer with supplies. However, Applicant submits that it is not the case that the printer is merely being checked and replenished by the consumer: these tasks are being performed specifically by an entity who is not the consumer. In other words, Applicant submits that it is not notoriously well known for a provider with whom the consumer has submitted a request for a transaction confirm that the printer has sufficient supplies and replenish the printer with supplies. Furthermore, Applicant submits that no prior art has been cited by the Examiner anticipates or suggests that the provider/intermediary confirm that the printer has sufficient supplies and replenish the printer with supplies (nor does any cited prior art anticipate or suggest the specific combination of the provider/ intermediary providing these services along with the direct transference of data to print, say, original documents). Applicant thus requests, under 37 CFR 1.104(d)(2), that if the Examiner continues to assert that it is notoriously well known, the Examiner provide an affidavit in support of the Official Notice taken based on the Examiner's personal knowledge.

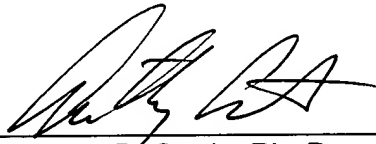
In addition, Claims 32 and 36-37 are independently patentable. No motivation has been provided by either Ryan or Golden to combine the closed system, direct printing metered stamp method of Ryan with the open system, customer-directed (indirect) printing certificate method of Ryan. Further, Claim 36 recites defacing the printed material and sending an image of the printed material in defaced form to the remote provider. Neither Ryan nor Golden anticipates or suggests such a method. Instead, Official Notice has again been taken of "the notoriously well known concept and benefits of defacing the printed material and sending an image of the printed material in defaced form to the remote provider." However, the defacement and sending of the image is being provided to a specific entity: the remote provider who direct controlled the printing of the original printed material without involvement of the consumer. Applicant thus again requests, under 37 CFR 1.104(d)(2), that if the Examiner continues to assert that this is notoriously well known, the Examiner provide an affidavit in support of the Official Notice taken based on the Examiner's personal knowledge.

For at least these reasons, Applicant submits that Claims 6, 10-13, 15-19, 22, 27, 32, 36-40, 42-45, 57-59, 61, and 64-67 are independently patentable over the prior art cited by the Examiner.

Conclusion

In view of the amendments and arguments above, Applicant respectfully submits that all of the pending claims are in condition for allowance. If for any reason the Examiner is unable to allow the application in the next Office Action and believes that a telephone interview would be helpful to resolve any remaining issues, he is respectfully requested to contact the undersigned agents or attorneys.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Anthony P. Curtis', is written over a horizontal line.

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APPENDIX A
DIRECT ELECTRONIC BUSINESS TRANSACTION
Serial No. 09/612,407
Junichi Umehara

In the Specification

Please amend the paragraph on page 1, line 27 - page 2, line 14 as follows:

Figure 1 shows a traditional arrangement for electronic business transactions between an end-user and a product/service provider. In such a traditional arrangement, a user's printer 102 is connected to the user's computer system, television, or set up box 104, normally via a dedicated printer cable. The user's printer is under the control and command of the user's computer for printing materials that are downloaded to the end-user's printer 102 from the user's computer system 104 via the printer cable (not shown). The printer driver 108 residing in the user's printer 102 and the printer driver 106 residing in the user's computer system 104 communicate directly with each other to perform a print job. In this traditional arrangement, the user's printer 102 does not directly communicate with an online product/service provider, such as an airline company, computer system 110. Moreover, printing usually requires the end-user's involvement. As a result, the materials ~~form~~ from the product/service provider to be printed on the end-user's printer 102 have to be downloaded first to the end-user's computer system 104, via the communication channel 112, and then downloaded, by the end-user from the user's computer 104, to the end-user's printer 102. This process has several disadvantages.

Please amend the paragraph on page 3, lines 3-14 as follows:

Although some systems have been proposed wherein a product/server provider communicates printing data directly to the end-user's computer, these systems have limited printing capabilities. For example, U.S. Patent No. 5,319,562 discloses a system wherein the end-user computer system includes an end-user's printer and a postage printing program for directing the end-user's printer to print address and postage on envelopes and labels. In this system, however, the end-user has to have a postage printing program and a postage meter to keep track of postage purchased by the end-

user and the postage applied to mail pieces by the end-user's printer. Moreover, the end-user has to use his or her computer to direct his or her printer to print the postage. In addition, the system and method of this patent does not print an original stamp, like one directly purchased from the United States Post Office.

In the Claims

Please amend Claims 1, 5-7, 13, 16, 20, 22, 23, 30, 42, 46, 50, and 54 as follows:

1. (Amended) A method for conducting electronic transactions, the method comprising:

(a) establishing a first communication connection to a provider from a consumer;

(b) submitting to the provider a request for a transaction;

(c) processing said transaction, and generating electronic certificate data;

(d) establishing a second communication connection from said provider to said consumer's printer;

(e) transmitting said electronic certificate data at least partially contained within an image file to said consumer's printer; and

(f) controlling the printing of an electronic certificate by the provider to print the certificate on said consumer's printer.

5. (Amended) The method of claim 44, wherein said processing includes:

(g) confirming said consumer identification information; and

(h) confirming said printer identification information.

6. (Amended) The method of claim 1, wherein said establishing communication connection includes:

(g) said provider confirming that said printer has sufficient supplies; and

(h) said provider replenishing said printer with supplies.

7. (Amended) The method of claim 1, further including

- (g) providing an identification indicia for printing on said electronic certificate;
- (h) transmitting said identification indicia data along with said image file to said consumer's printer; and
- (i) printing said identification indicia on said electronic certificate.

13. (Amended) The method of claim 1, wherein said printing includes:

- (g) printing an original stamp.

16. (Amended) The method of claim 1 further including:

- (g) requesting said user-consumer to make a payment for said electronic transaction; and

- (h) confirming said payment.

20. (Amended) A method for conducting electronic transactions, the method comprising:

- (a) requesting a transaction from a provider;

- (b) transmitting authorized document data at least partially contained within an image file to a consumer's printer that is under direct control of said provider in response to said transaction; and

- (c) printing said authorized document with said consumer's printer.

22. (Amended) The method of claim 21, further including:

- (e) said provider directly confirming that said consumer's printer has sufficient supplies to print said authorized document; and

- (f) said provider automatically replenishing said consumer's printer with supplies.

23. (Amended) A system for issuing and printing authentic certificates for a consumer, comprising:

(a) a provider information processing system that receives request for an authentic certificate and generates said authentic certificate, said processing system providing printing instructions for printing said authentic certification;

(b) a network connecting said processing system to a plurality of user's; and

(c) a printer connected to a point on said network in communication with said provider information processing system, such that said consumer's printer receives authentic certificate data and printing instructions from said provider information processing system and prints the authentic certificate according to said printing instructions, at least one of the authentic certificate data and printing instructions at least partially contained within an image file.

30. (Amended) A printing device associated with a consumer, comprising:

(a) means for receiving printing data and printing instructions from a remote provider; and

(b) means for printing said printing data according to said printing instructions under said remote provider's direct control without involvement of said consumer, wherein when an image file that contains at least a portion of said printing data is present, the image file is printed by the means for printing.

42. (Amended) A method for checking that a user's printer has sufficient printer supplies by a remote provider, said method comprising:

(a) establishing communication with said user's printer by said remote provider;

(b) said remote provider receiving information about said printer supplies; and

(c) said remote provider determining sufficiency of said printer supplies.

46. (Amended) A method for printing original documents at a user location, the method comprising:

(a) establishing communication from a first processor associated with an authorizer of the printing of the original document to a user printer at the user location, the communication including transfer of an image file containing at least a portion of the original document;

(b) printing the original document with the user printer; and

(c) controlling (b) independent of a printer driver on a computer at the user location.

50. (Amended) A method for printing original documents at a user location, the method comprising:

(a) printing an original document at least partially contained within an image file with a printer responsive to a printer resident driver; and

(b) authorizing (a) with a driver resident on a processor geographically remote from the printer.

54. (Amended) A method for printing original documents at a user location, the method comprising:

(a) transmitting first data for a first original document to a printer via a computer network;

(b) printing the first original document responsive to the first data with a printer;

(c) transmitting second data for a second original document to the printer via the computer network, the second original document being a different type of document than the first original document, at least one of the first and second original document at least partially contained within an image file; and

(d) printing the second original document responsive to the second data with the printer.